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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHANNAVAJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 06/03/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/298,245

Applicant(s)

CHEN, JAU-FEI

Examiner

Lakshmi S. Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 10-26 and 29-41 is/are pending in the application.
- 4a) Of the above claim(s) 35-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 10-26 and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Receipt of request for extension time and amendment C, both dated 3-12-02 is acknowledged.

Claims 1-4, 6-9, 27 and 28 have been canceled in this amendment. New claims 31-41 have been added. Claims 5, 10-26 and 29-41 are pending.

Election/Restrictions

Newly submitted claims 35-41 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: new claims 35-41 are directed to a method of delivering vitamins to a section of skin by applying cactus fruit extract and a natural skin supplement. The originally presented composition claims can be used as a bar soap, a facial cleanser, a shampoo or a toothpaste and does not require the presence of vitamins. Thus, the composition is used for different purpose other than claimed method. Therefore, the composition is distinct from the method.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 35-41 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

In view of cancellation of claims 1-4, 6-9, 27 and 28, the following rejection has been withdrawn:

1. Claim 1 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 2703189 (DE '189).
2. Claims 1-3, 6-9 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 2703189 (DE '189).

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The following rejection has been maintained for the reasons of record:

3. Claims 1-9, 13-23, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 2703189 (DE '189) and US 5,578,312 to Parrinello in view of DE 2732749 (DE '749) and CN 1033278 (CN '278).

DE discloses a cosmetic cream containing cactus fruit juice (extract) and other natural ingredients. DE '189 fails to teach one specific type of extract, such as ginseng root or berry extract of the instant claims.

Parrinello teaches a skin care system for moisture retention in skin comprising a composition made from a mixture of dried herbs, leaves, fruits, roots, juices, flowers etc., from plants along with other surfactants, emulsifiers, preservatives etc. Parrinello teaches a number of cosmetic forms such as gel, lotion, mask, cleansers etc (col. 2, lines 7-16 and examples).

Among other herbal/plant extracts, Parrinello teaches ginseng extract in a moisturizer, mask, cleanser (see examples) etc. Parrinello does not teach cactus fruit extract. However, it would have been obvious for a skilled artisan at the time of the instant invention to add the cactus fruit juice of DE '189 to the skin moisturizing composition of Parrinello containing several plant/herbal extracts, including ginseng, because, DE '189 teaches cactus fruit juice is effective for skin wrinkles and can be combined with other natural ingredients and Parrinello also teaches all natural extracts for moisturizing skin and removing wrinkles. The "comprising" language of the instant claims does not exclude the presence of various other extracts of Parrinello.

Parrinello does not teach ginseng berry or root or even specify the type of ginseng extract.

However, choosing a suitable type of extract (of ginseng) without sacrificing the moisturizing

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effect of the extract would have been within the scope of a skilled artisan because the prior art teaches the moisturizing effect in ginseng extract.

However, DE 2732749 and CN '278 teach triterpenes are present in ginseng root and ginseng fruit respectively. Thus, the active component, triterpene, is present in both roots and fruit of ginseng. Accordingly, it would have been obvious for a skilled artisan at the time of the instant invention to use either ginseng root (CN '278) or ginseng fruit (DE '749) in the composition of Parrinello and still expect the same anti-wrinkle and skin moisturizing activity of the composition. Further, absent showing evidence on the contrary, the skin moisturizing and wound healing properties are implicit to the cactus extract of DE '199.

Response to Arguments

Applicant's arguments filed 3-12-02 have been fully considered but they are not persuasive.

Applicants argue that the prior art references do not teach or suggest instant skin care product having a ginseng *berry* extract, as in claim 5 and 13. They argue that DE '189 teaches juice from cactus species as one of the plant extracts, Parrinello teaches a cleanser containing 'ginseng' as one of the several ingredients. Applicants submit that the dictionary definition of the term ginseng relates only to root and not the berry and hence applicants argue that the Parrinello reference does not teach ginseng berry extract.

These arguments are not persuasive because, instant comprising language allows for the presence of all the other ingredients taught by DE '187 and Parrinello. Further, instant product claim is broad and encompasses the cleanser of Parrinello.

Applicants argue that while the process of extracting triterpenoids, taught by CN '278, might be termed as "ginseng berry extract", they argue that the extract of CN '278 is different the instant extract because, the instant extract is prepared in a different way (pages 10-11 of the instant application). However, instant claims do not specify any specific process of preparing the extract. The claims also do not distinguish the instant ginseng berry extract from that of the prior art nor do they specify the chemical constituents of the extract i.e., such as riboflavin or beta-carotene or other vitamins. Besides, applicants state that the instant extract is more than triterpenoids, thus agreeing that triterpenoids of CN '278 are included in the instant ginseng berry extract. Thus, the prior art references teach instant composition.

Applicants argue that while Parrinello does not teach ginseng extract as a moisturizer, they state that because ginseng root is aromatic and because Parrinello teaches essential oils are added to moisturizer and cleanser, it is plausible that the ginseng extract might be added to provide fragrance. However, this argument is not persuasive because Parrinello clearly teaches ginseng in the moisturizer composition, exemplified in Example A. Besides, Parrinello nowhere states oils form ginseng root. Therefore, applicants' interpretation of the reason for adding ginseng extract is not persuasive.

Applicants argue that DE '749 does not teach triterpenes in ginseng root and only teaches in birch leaves. However, the title of the reference clearly states ginseng root saponin glycosides, which by definition include triterpenoid glucosides. With respect to applicants' argument that that examiner's motivation to combine the references ignores the inherent difficulty of using berries (due to their small size and high seed content) as a herbal supplement. They further argue that this is further evidenced by wide spread use of ginseng root as opposed to berry. However,

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examiner has clearly shown that the prior art recognizes triterpenoids as active components in both ginseng root and berries. Accordingly, absent any criticality in the effect, one of an ordinary skill in the art would use either sources of ginseng and still expect the same result. Thus, whether the use of ginseng berry extract is obvious or not has been properly addressed by the examiner and hence the rejection is deemed to be proper.

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 703-308-2438. The examiner can normally be reached on 7.30 AM -4.00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7924 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Lakshmi S Channavajjala
Examiner
Art Unit 1615
May 21, 2002

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600